

REMARKS

The Office examined claims 1-28 and 30-43 and rejected each. With this paper, claims 1, 3-4, 6-9, 11, 14-18, 20-25, 28, 30-35, 38, 40 and 42 are amended, and no claims are added or cancelled so that claims 1-28 and 30-43 remain in the application. Claims 1, 10, 19, 28, 30, 31, 32, 35, 38 and 40 are the independent claims.

Various claims have been amended to shorten preambles. Claim 7 is amended to be dependent on claim 41, claims 8-9 are amended to be dependent on claim 40, and claims 22-25 are amended to be dependent upon claim 36. Claim 11 is amended to correct an antecedent basis error. Claims 3-4, 6-7, 14-18 and 20-25 have been amended to replace the word "it" with the appropriate corresponding claimed element. Claim 42 has been amended to incorporate the features of claim 32. No new matter has been introduced by way of amendment.

Claims 30-32, 35 and 42 have been amended to replace "the user equipment is being handed over" with --scheduling control is being transferred--. Similarly, claims 1 and 28 have been amended to include "scheduling control of" language. Support for the amendments can be found in the specification as originally filed at page 11, line 14 through page 12, line 29, page 13, line 31 through page 14, line 34 and page 15, lines 19-23. No new matter has been introduced by way of amendment.

Objection to the Claims

At section 1 of the Office action, the Office objects to claims 28 and 19 for being directed to a computer program product while depending from a method claim, thereby creating a hybrid claim. Applicant assumes that the objection was intended to be directed to claims 28 and 29 as claim 19 is not a computer program product claim. Claim 29 has been cancelled previously,

and claim 28 is amended to comprise all the limitations corresponding to claim 1. As amended, the computer readable storage media embodies computer code for performing a method. Applicant respectfully submits that it is not improper to have a claim in which computer code performs a method, thus, applicant respectfully submits that this is not a hybrid claim. Applicant, therefore, respectfully requests withdrawal of the objection of claim 28.

Claim Rejections under 35 USC §101

At sections 7-8 of the Office action, claim 28 is rejected under 35 USC §101 as being directed to non-statutory subject matter. The Office states that the claimed invention falls in a judicial exception of an abstract idea without a practical application by physical transformation and without a useful and tangible result. At section 3 of the Office action, the Office acknowledges Applicant's amendment to claim 28, but asserts that claim 28 still does not show a useful and tangible result.

Claim 28 is amended so as to include all the limitations of the method of claim 1. As originally filed, the computer program code of claim 28 included instructions for executing the method of claim 1. As amended, claim 28 possesses a practical application with a useful and tangible result for at least the reason that claim 28 contains the limitations of claim 1 and claim 1 possesses a practical application with a useful and tangible result. Applicant therefore respectfully requests that the rejection of claim 28 under 35 USC 101 be withdrawn.

Claim Rejections under 35 USC §103

At sections 9-12 of the Office action, claims 1-5, 10-16, 19-21, 26-28, 30-40 and 42-43 are rejected under 35 USC §103(a) as being unpatentable over 3GPP; Technical Specification Group

Radio Access Network; Feasibility Study for Enhanced Uplink for  
UTRA FDD; (R. 6) 3GPP TR 25.896 V0.3.2. (hereinafter TR 25.896)  
in view of US Pat. No. 7,184,413 to Beyer et al. (hereinafter  
Beyer).

**STATEMENT ESTABLISHING COMMON OWNERSHIP**

Applicant asserts that present application no. 10/648,778 and prior art patent no. 7,184,413 were, at the time the invention of application no. 10/648,778 was made, commonly owned by Nokia Corporation and its subsidiary Nokia Inc.

35 USC §103(c) states:

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

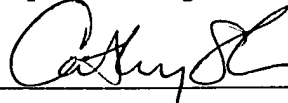
U.S. Patent no. 7,184,413 to Beyer is only available as 35 USC §102(e) prior art because the filing date of the claimed invention (August 25, 2003, application no. 10/648,778) is prior to the publication date of Beyer (May 18, 2006, US Pub. No. 2006/0104301). Thus, in accordance with 35 USC §103(c), applicant respectfully asserts that U.S. Patent 7,184,413 to Beyer et al. cannot be used as a prior art reference in view of the common ownership of the present invention and the Beyer reference at the time the invention was made.

Applicant therefore respectfully requests that the rejection of all claims under 35 USC 103 be reconsidered and withdrawn.

CONCLUSION

It is believed that all of the claims of the application are in condition for allowance and their passage to issue is earnestly solicited.

Respectfully submitted,



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10.23.08

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